

Appl. No. : 10/541,281
I.A. Filed : December 31, 2003

REMARKS

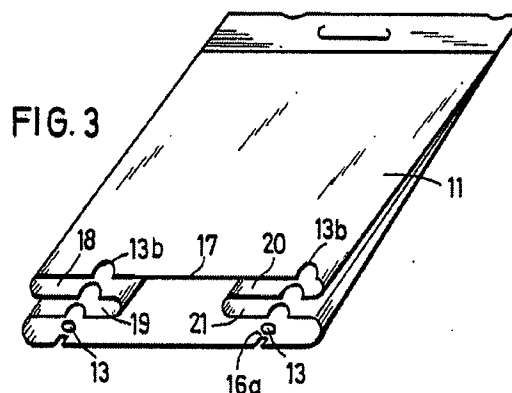
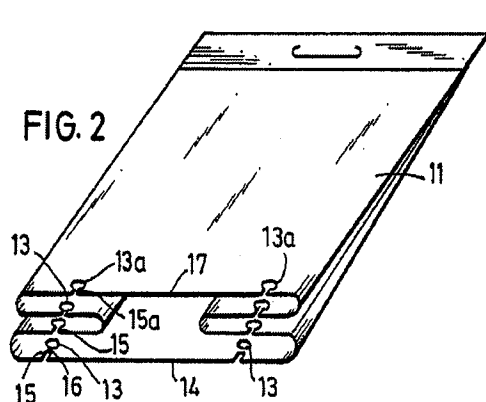
Claims 1, 4, 6, and 21 stand rejected. Claims 7 through 15 stand withdrawn. Applicant has added Claim 22 by the amendments above. Claim 22 is at least supported by Figure 5 of the originally filed specification. Thus, Claims 1, 4, 6, 21, and 22 are pending in the application. Applicant respectfully requests reconsideration of the pending claims in view of following remarks.

Discussion regarding Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1, 4, and 6 under 35 U.S.C. § 102(b) as being anticipated by Sengewald (U.S. Patent No. 4,779,996). Applicant respectfully submits that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” and that “[t]he elements must be arranged as required by the claims.” *See MPEP § 2131*. Applicant further submits that each and every element of Claim 1 is not found, either expressly or inherently, in Sengewald.

Claim 1 is directed towards “a bundle of flattened foil bags having a generally uniform thickness and configured to be supported on a pin support of a foil bag opening machine,” and recites, *inter alia*, “a plurality of first incisions ... having a closed shape substantially equal to a cross-sectional shape of the pin support.” Sengewald fails to disclose this feature.

Sengewald generally discloses, at column 2, lines 5-14, “a pouch” in which “the upper foil layer has also a suspension opening with a slot which communicates the suspension opening with the associated edge of the pouch.” An embodiment of such a pouch is shown in Figure 2, reproduced below. Sengewald also discloses, at column 2, lines 32-37, “instead of a slot ... the opening in the remaining foil layers extend directly to the filing edge and in an especially simple manner by the respective selection of a greater diameter.” An embodiment of such a pouch is shown in Figure 3, reproduced below.



Sengewald discloses that the “suspension holes have two functions,” (c. 1, l. 26) namely “fasten[ing] the pouches after their production on pins for providing a stacking” (c. 1, ll. 29-30) and “h[o]ld[ing] on pins for their simplified delivery” (c. 1, ll. 31-32). Sengewald does not further discuss the relationship of the pins and the suspension holes, thus Sengewald does not disclose, at least, “a closed shape substantially equal to a cross-sectional shape of the pin support” as recited in Claim 1.

In contrast, the present application discloses, at paragraphs [0011] and [0012] that “the rearward bag portion may not easily be allowed to be pulled off from the pin supports” and “the forward flattened foil bag is provided with incisions” such that the one can “easily pull off the front foil bag portion from the support pins.” Thus, the incisions of the present application allow the front portion of the bag to be removed more easily than the rearward portion. Neither the incisions on the front or rear portions are torn to remove the bag from the support pins.

As Sengewald fails to disclose every limitation of Claim 1, Applicant respectfully submits that Claim 1 is not anticipated by Sengewald. Claims 4 and 6 depend directly from Claim 1 and, thus, are patentable for at least the same reasons that the claim from which they depend is patentable over the applied art. Therefore, Applicant respectfully submits that Claims 4 and 6 are also not anticipated by Sengewald. Applicant therefore requests withdrawal of the rejection under 35 U.S.C. § 102(b).

Discussion of the Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1, 4, 6, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Wilfong, Jr. (U.S. Patent No. 4,995,860) in view of Sengewald or Conrad

(U.S. Patent No. 5,062,716). The Examiner suggested that “it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the embodiment of Figure 19 of Wilfong or Sengewald or Conrad’716 to modify the plurality of first incisions in the embodiment of Figures 11-12 of Wilfong so the plurality of first incisions comprise a closed shape to facilitate through a pin support and the selection of the specific shape for the first incisions such as the shape of Wilfong or Sengewald or Conrad’716 would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well.”

Applicant respectfully notes that “design choice” is not a grounds for rejection under § 103. Design choice, as discussed in the MPEP at § 2144.04(VI)(C) only applies when the design choice constitute a rearrangement of parts. The selection of the specific shape for the first incisions cannot be considered a “rearrangement of parts.” Further, as stated in the MPEP at the same section, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

As recently confirmed by the Supreme Court (see *KSR v. Teleflex*, 550 U.S. 297 (2007), 82 USPQ2d 1395), “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art” but rather that there must be some “reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”

The Examiner also stated that “the resultant structures will work equally well.” Applicant submits the bags of Wilfong, Sengewald, and Conrad’716 serve different purposes. In particular, Wilfong discloses a bag for manual use which is “partially held on the rack in the opened position during loading” (Wilfong at abstract). In comparison, Sengewald discloses “a pouch which can be torn off” (Sengewald at c. 1, l. 66) prior to filling. Conrad’716 discloses a bag for automatic use which “fully opens during loading and easily releases after loading” (Conrad at c. 2, ll. 55-56).

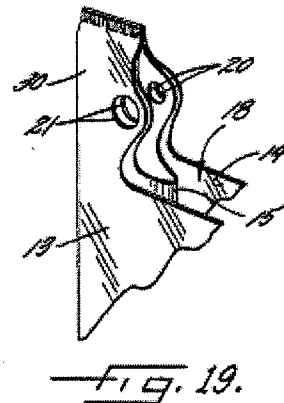
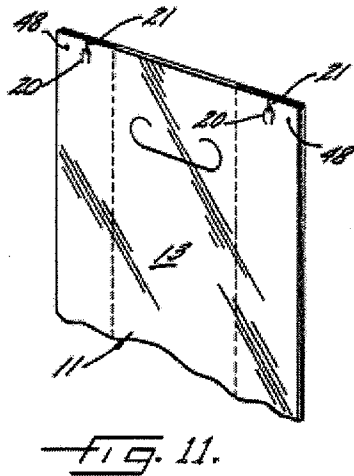
Applicant respectfully submits that, as stated in the MPEP at § 2143, “The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as

Appl. No. : 10/541,281
I.A. Filed : December 31, 2003

claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.” Applicant further submits that at least one claimed element of Claim 1 is not disclosed in the cited art.

With respect to Wilfong Jr. (Figure 11) and Wilfong Jr. (Figure 19)

Claim 1 recites, *inter alia*, “the first incisions having a closed shape substantially equal to a cross-sectional shape of the pin support.” Wilfong Jr. does not disclose this feature. Wilfong Jr. discloses, with respect to Figure 11 (reproduced below), at column 8, lines 16-19, “the bag mounting apertures 20 are formed by a cut which does not completely close and thereby leaves flap portions in the apertures.” Wilfong Jr. also discloses, with respect to Figure 19 (reproduced below), at column 8, lines 20-28, “the additional cut means 21 for effectively enlarging the bag mounting apertures 20 ... comprises a cut ... to enlarge such apertures 20 to a size larger than the enlarged portions 27 on the free other end portions of the sub shaft supports 26.” The Examiner proposes combining the embodiment of Figures 11-12 with the closed shape of the embodiment of Figure 19. However, the proposed combination would not result in “first incisions having a closed shape substantially equal to a cross-sectional shape of the pin support.” Further, one of ordinary skill in the art would not be motivated by the disclosure of Wilfong Jr. to produce a bag having two “additional cut means 21 for effectively enlarging the bag mounting apertures 20” (Wilfong Jr. at c. 8, ll. 20-21) as the second cut means would be redundant and simply add addition manufacturing costs. As Wilfong Jr. fails to disclose “a closed shape substantially equal to a cross-sectional shape of the pin support,” a *prima facie* showing of obviousness has not been made with respect to this reference.



With respect to Wilfong Jr. and Sengewald

Claim 1 recites, *inter alia*, “the first incisions having a closed shape substantially equal to a cross-sectional shape of the pin support.” As discussed above, Wilfong Jr. does not disclose this feature. Sengewald also fails to disclose such a feature. Although Sengewald discloses, at column 1, lines 30-31, that the “pouches are held on pins,” the document does not disclose that the first incisions have a closed shape substantially equal to a cross-section shape of the pin support. With respect to the size of the suspension openings, Sengewald discloses, at column 3, lines 59-63, that “the upper foil layer 11 and the side folds 18, 19, and 20, 21 can be provided with suspension openings of a different diameter or with slots of different length than in the lower foil layer 12.” As neither reference discloses “a closed shape substantially equal to a cross-sectional shape of the pin support,” a *prima facie* showing of obviousness has not been made with respect to these references.

With respect to Wilfong Jr. and Conrad

Claim 1 recites, *inter alia*, “the first incisions having a closed shape substantially equal to a cross-sectional shape of the pin support.” As discussed above, Wilfong Jr. does not disclose this feature. Conrad also fails to disclose such a feature. Although Conrad discloses, at column 4, lines 50-51, that “there are formed wicket opening 10 adapted to receive storage wickets,” the document does not disclose that the first incisions have a closed shape substantially equal to a cross-section shape of the pin support. As neither reference discloses “a closed shape

Appl. No. : **10/541,281**
I.A. Filed : **December 31, 2003**

substantially equal to a cross-sectional shape of the pin support,” a *prima facie* showing of obviousness has not been made with respect to these references.

As none of the cited references disclose or teach at least “the first incisions having a closed shape substantially equal to a cross-sectional shape of the pin support” as recited in Claim 1, Applicant respectfully submits that Claim 1 is not obvious. Claims 4, 6, and 21 depend directly from Claim 1. Applicant respectfully submits that, as stated in the MPEP at § 2143.03, “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” Therefore, Applicant respectfully submits that Claims 4, 6, and 21 are also not obvious. Applicant therefore requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Discussion of New Independent Claim 22

New Claim 22 is being added to provide a differing scope of protection. Claim 22 is directed to the species elected by Applicant on January 31, 2008.

Appl. No. : 10/541,281
I.A. Filed : December 31, 2003

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Additionally, any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

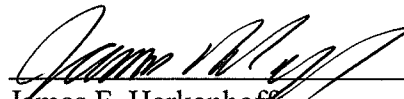
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

4/6/09

By: _____



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